UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,210	07/09/2001	Royce J. Bowles JR.	17342-0011	6398

29052 7590 03/07/2003

SUTHERLAND ASBILL & BRENNAN LLP
999 PEACHTREE STREET, N.E.
ATLANTA, GA 30309

EXAMINER
LORENGO, JERRY A

ART UNIT	PAPER NUMBER
1734	7

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-7

Office Action Summary	Application No. 09/901,210	Applicant(s) BOWLES ET AL.	
	Examiner Jerry A. Lorengo	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *14-26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-26* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

(1)

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-13, drawn to a method for printing on an article, classified in class 156, subclass 230.

II. Claims 14-26, drawn to a decorated article, classified in class 428, subclass 914.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as by hand painting, in-mold transfer or lay-up lamination.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Peter Pappas on March 3, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-26Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

(2)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 7, 8, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 913440 A1 to Otaki et al. in view of JP 03-63199 to Nakanishi.

Regarding applicant claim 1, Otaki et al. disclose a method for the decoration of an article comprising the steps of:

(1) Printing a four-color image (blue, yellow, red and black or white) onto a water-soluble polymer film (page 5, ¶ [0034]) with solvent based inks (page 5, ¶ [0042]);

(2) Liquefying the solvent based ink image by way of a solvent activator applied thereto (page 5, ¶ [0036]);

(3) Placing the printed water-soluble polymer film carrying the solvent based ink image thereon onto the surface of a water bath whereby the water soluble film is at least partially dissolved, e.g., softened and swelled (page 5. ¶ [0037]); and

(4) Pressing and submerging the article to be decorated against the liquefied solvent based ink image to transfer the liquefied solvent based ink image to the surface of the article (page 5, ¶ [0039]).

Although Otaki et al. disclose, as per applicant claims 7, 8 and 13, that the solvent based ink image is printed by rotogravure printing on a water-soluble PVA film and placed on the surface of a water bath such that the ink image is facing away from the surface of the water (page 5, ¶ [0034] and [0037]), they do not specifically disclose, as per applicant claim 1, that the solvent-based ink image is provided by way of a digital image file. They also do not specifically disclose that the solvent activator is applied to the solvent-based ink image after the water-soluble film carrying the ink image has been placed onto the surface of the water bath.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the printed ink image by way of a digital image file motivated by the fact that Nakanishi, also drawn to methods for the transfer solvent-based ink images from a water-soluble film onto an article surface by way of float transfer, discloses that image making up the printed image can be composed manually or digitally through the use of a computer (abstract; Figures 1-6). It would have also been obvious to apply the solvent activator onto the solvent-based ink image either before or after the water-soluble film carrying the ink image has been placed onto the surface of the water bath, motivated by the fact that Nakanishi (through his illustrations) discloses that either method is acceptable and functionally expedient (abstract; Figures 1-6).

Although Otaki et al. is silent to the matter, it would have been obvious to one of ordinary skill in the art at the time of invention, as per applicant claim 10, to wash any residual water-soluble polymer film from the article after transfer motivated by the fact that Nakanishi discloses that such a step is known (Figure 6).

(3)

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (2), above, in further view of U.S. Patent No. 4,436,571 to Nakanishi.

The references as combined in section (2), above, disclose a method for the transfer of solvent-based ink images from a water-soluble film onto an article surface by way of float transfer. Although they do not specifically disclose, as per applicant claim 9, that the article is primed by the application of a layer of primer thereto, it would have been obvious to one of ordinary skill in the art at the time of invention to do so motivated by the fact that Nakanishi, also drawn to methods for the transfer solvent-based ink images from a water-soluble film onto an article surface by way of float transfer, discloses that if primer coating is required as a base coating on the article to be printed, a primer coating device may be employed to apply the coating thereto prior to transfer decorating (column 6, lines 10-17).

(4)

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (2), above, in further view of U.S. Patent No. 4,231,829 to Marui et al..

The references as combined in section (2), above, disclose a method for the transfer of solvent-based ink images from a water-soluble film onto an article surface by way of float transfer. Although they do not specifically disclose, as per applicant claim 11, that the article is provided with a finish coating after transfer decoration, it would have been obvious to one of ordinary skill in the art at the time of invention to do so motivated by the fact that Marui et al., also drawn to methods for the transfer solvent-based ink images from a water-soluble film onto an article surface by way of float transfer, discloses that a surface finishing may be carried out by applying a top coating to the pattern-transferred surface of the object in order to protect the surface (column 8, lines 1-3).

(5)

Claims 2-6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (2), in further view of U.S. Patent No. 5,695,587 to Dumoux.

The references as combined in section (2), above, disclose a method for the transfer of solvent-based ink images from a water-soluble film onto an article surface by way of float transfer. Although they disclose that the printed image may be generated manually or through the use of digital devices (computers), they do not specifically disclose the particulars of the design or digital system set forth in applicant claims 2-6. They are also silent as to the registration of printing process set forth in applicant claim 12.

Regarding applicant claims 2-6, the particulars of the digital imaging and lay-up would have been obvious to one of ordinary skill in the art at the time of invention motivated by the fact that Dumoux, also drawn to methods for the transfer solvent-based ink images from a water-soluble film onto an article surface by way of float transfer, discloses the image formation is preferably controlled by a computer system associated with databases containing images, printing parameters, polysensory data, designs, and a digital image scanner, a device for synthesizing images and designs, and a display device for providing a three-dimensional display of the coated article with realistic rendition so as to enable certain print parameters to be readjusted prior to launching real printing (column 4, line 66 to column 5, line 10).

Although Dumoux does not specifically disclose that the design is a camouflage pattern made up of individually composited vegetation components, it would have been obvious to one of ordinary skill in the art at the time of invention to provide any particular design, pattern, etc. motivated by the fact that the choice of design is dictated by aesthetic concerns only. Furthermore, it has been held that that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.[1]

Regarding applicant claim 12, although the prior art of record is silent as to the degree of registration utilized in printing the colors of the image onto the water-soluble film, the claimed registration parameters would have been the result of routine experimentation by one of ordinary skill in the art taking into consideration the substrate to be printed on, the rheology of the inks, the expansibility of the water-soluble film encountered when placed upon the water bath, etc.

(6)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (703) 306-9172. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7115 for regular communications and (703) 872-9311 for After Final communications.

[1] *See, e.g., In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

J.A. Lorengo
Primary Examiner
AU 1734
March 5, 2003